

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MacLean, *et al.* Docket No.: NOR-14892
Serial No.: 10/027,777 Art Unit: 3684
Filed: December 26, 2001 Examiner: Swartz, Jamie H.
For: Content-Based Billing Service for Wireless Prepaid Subscribers

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Claims 1-4, 6-10, 12-16 and 18-21 were finally rejected under 35 U.S.C. § 112, first paragraph, on the allegation that there is not adequate support for the claim language in claims 1 and 13 that states "at said GGSN, accumulating only a billable data count." Claims 1-4, 6-10, 12-16 and 18-21 were also finally rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of the 5 references Haumont, Alloune, Cushnie, Kati et al. and Faccinn et al. In view of the presence of these clearly improper rejections based upon errors of fact, this application is an appropriate candidate for the Pre-Appeal Brief review process.

With respect to the 35 U.S.C. § 112 rejection, the Examiner was of the opinion that there was no support in the specification for the phrase “at said GGSN, accumulating only a billable data count.” However, page 3, lines 16 and 17 state “--- the GGSN *will not* accumulate a data count for data designated as non-billable or “free” data”. Further, page 3, line 13 states “the billable data is accumulated at the GGSN”, yet there is no mention of non-billable data. Even when the specification refers to the GGSN accumulating different types of data, it is clear that the different types of data are all billable data. See page 3, lines 16 – 19 that state “--- the GGSN may accumulate different types of data at different billable data counts or rates.” Also, the original claim 7 which, of course, is part of the original disclosure requires that --- a first type of data is provided at no cost to the subscriber and *does not accumulate at said GGSN* ---.” Finally, page 7, lines 13 and 14 states, [thus, the GGSN 22] is provided to keep track of the non-free internet data --- .”

Applicant’s attorney was not certain whether the Examiners § 112 rejection was to just the quoted phrase of the claim element or to the entire element, including comprising only said second type of data. If the rejection was also to the remainder of the element, it is noted that lines 13-14, at page 12 specifically state that “the GGSN 22 will accumulate data [data count] at a slower and lesser rate than the SGSN 20.” Therefore, the SGSN 20 must be accumulating data [data count] if it is accumulating the data count slower than the GGSN 22 is accumulating a data count. Also, lines 15-17 at page 12 states that “*the SGSN 20* will not report ---until instructed --- no matter what *its own count* of the data bits.” Likewise, page 14, lines 3-6 state that “the data count for GGSN 22 will be lower than the *data count for SGSN 20*---” and “[c]onsequently rather than simply sending *the data count* from SGSN 20---.” It is believed these statements are irrefutable support that the SGSN 20 does accumulate a data count.

With respect to the 35 U.S.C. § 103(a) rejection, the penultimate element of the single independent claim 1 requires “transmitting said accumulated billable data count of said second type --- from said GGSN to---[the] SGSN ---.” It is submitted, however, that several of the allegations on pages 6, 7 and 8 of the Office Action are not supported by the cited references. Specifically, the Examiner alleges that Haumont teaches transmitting the accumulated data account to the first SGSN because paragraphs 15, 28, 32-34 and 80-81 of Haumont “teaches transmitting the accumulated data count to the SGSN---,” and that paragraphs 32- 34, 40, 42 and 57 teach “ providing that accumulated data count to the SCP”. However, there is no teaching whatsoever in Haumont of transmitting the accumulated data count to the SGSN or providing the accumulated data count to the SCP. More specifically, and to the contrary, paragraphs 32-34 teach that the SCP obtains the account balance, but only indicates in a response to the SGSN “if the balance exceeds the limit.” An “exceeded” or “not exceeded” response is not the same as an accumulated data count. Further, there is certainly no teaching that an accumulated data count comprises two types of data (both said first and second types) as required by the claim. Also, as discussed above, although the Examiner implied at page 6, line 11 of the Office Action that the accumulated data count was transmitted from the GGSN to the SCP, at page 7, lines 14 the Examiner acknowledges that “Haumont does not specifically teach the data being transferred from the SGSN to the SCP”, and brings in still another reference (Cushnie) to try and prop up his position. In fact, Haumont teaches away from the claim language in that any information transmitted or transferred between the SCP and the GGSN of Haumont must first go through the Haumont SGSN.

Then, importantly, at page 8, lines 19 and 20, the Examiner admits that “Haumont does not specifically go into the details of transferring billable data count from the GGSN to the

SGSN”, but states that paragraph 17 of Faccinn et al. “teaches that the data count is transmitted from the GGSN to the SGSN.” However, despite the allegation of the Examiner, it is clear that paragraph 17 of Faccinn et al. does not teach that the data count is transmitted from the GGSN to a SGSN. To the contrary, Faccinn teaches that the SGSN creates a “Create PDP Context Request” message and sends it to the GGSN, and in response the GGSN creates a “Create a PDP Context Response” that is then forwarded to the SGSN. It is well known that PDP stands for Packet Data Protocol, and although the PDP may provide some information about the data, such data packet protocol simply is not the “accumulated data count” as required by the claims. Paragraph [0008] of Faccinn discusses the information that concerns the PDP. The “billable data count” is simply not protocol, nor is it indicated as being part of the PDP request.

Thus, it is clear that, whether considered singly or in combination, the five references applied to the claims by the Examiner do not teach or even suggest all of the elements of the independent claims, and they certainly do not teach or even suggest the “transmitting” element of claims 1 and 13. Further, it is submitted that there is no incentive or true basis to combine the five references to arrive at this single claim element.

With respect to the fourth (4th) element of claim 1 that requires “accumulating a data count at said first SGSN comprising both said first type of data and said second type of data”, the Examiner admits that Haumont does not teach accumulating data of any type at the SGSN, but alleges the claim limitation is met by paragraphs 28 and 32-40 of Haumont. There is simply nothing in these paragraphs of Haumont to support the Examiner’s position.

It is respectfully submitted that the five references applied by the Examiner do not teach or make obvious all the elements of claim 1 or claim 13, whether considered singly or in combination and therefore claim 1 and claim 13 are clearly allowable. Further, since claim 1 and

claim 13 are the only independent claims, and the other claims all depend directly or indirectly from claim 1 or claim 13, it follows that these other claims are allowable for the same reasons discussed herein.

In view of the limited nature of this paper, Applicant has not raised all grounds or arguments. Rather, Applicant has attempted to focus on the clear errors in the rejection. In the event of a full appeal, Applicant will raise additional arguments.

Respectfully submitted,



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4/5/10

Date

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